

Serial No.: 10/656,706
Attorney Docket No. 02-003

REMARKS

In the Office Action, the Examiner required restriction to one of the following asserted inventions under 35 U.S.C. Section 121:

- I. Claims 1-10, drawn to method of synthesizing a compound, classified in class 564, subclass 133.
- II. Claims 11-17, drawn to method of preparing a copolymer, classified in class 526, subclass 307.2.
- III. Claim 18, drawn to a polymer, classified in class 526, subclass various.
- IV. Claims 19-20, drawn to copolymer, classified in class 525, subclass various.
- V. Claim 21, drawn to another polymer, classified in class 525, subclass various.
- VI. Claim 22, drawn to polymer of another formula, classified in class 525, subclass various.
- VII. Claim 23, drawn to random copolymer, classified in class 525, subclass various.
- VIII. Claim 24, drawn to polymer of another formula, classified in class 525, subclass various.
- IX. Claims 25-31, drawn to vinyl formamide, classified in class 564, subclass 223.

Specifically, the Examiner asserted that:

The inventions are distinct, each from the other because of the following reasons:

Inventions I and IX are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as by reacting corresponding amino compound with formic acid derivative.

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Inventions III and VI-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions belong to different polymers and copolymers and are independently functional without the need of the other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and being divergent subject matter, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

In view of the complex nature of the restriction requirement, a written restriction requirement is made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants hereby elect Claims 1-10 of Group I set forth by the Examiner with traverse.

Applicants respectfully requests that the Examiner indicate the allowability of the Claims and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,
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